

REMARKS

Claim 9 has been further amended to more clearly recite the subject matter that the applicant regards as his invention. In that regard, the amendments to claim 9 clarify within the body of the claim the relationship between the claimed support bracket and the overlying gutter cover panel that is recited in the preamble. Additionally, the support surface means is now clarified as engaging and supporting a rear surface portion of the gutter cover panel. And the matter of the bracket having a unitary body is included. The unitary recitation had been incorrectly designated in the amendment filed on October 2, 2008, by a strikeout as a deletion from claim 1, whereas it should have been designated in underlined form as an addition because it was not previously present in the claim. And that it was intended to be present in claim 9 as an addition and not as a deletion is evidenced by the fact that it was referred to in the Remarks section of that amendment in the discussion at page 6, line 7, and at page 8, line 5 of the second full paragraph.

In addition to the clarifying amendments to claim 9, claim 15 was amended to include the subject matter of claim 18. Accordingly, claims 5 and 18 have been canceled without prejudice or disclaimer, and claims 6 and 7 have been amended to depend from amended claim 9 instead of from canceled claim 5.

Claims 2-4, 9-13, 15, and 18 were rejected as anticipated by the Landis '803 reference. With respect to independent claim 9, from which each of the other claims depends, either directly or indirectly, there are very significant structural and functional differences between the invention as it is claimed in amended claim 9 and the structure and functional arrangement that is shown and described in the Landis

reference. Not the least of those differences is that amended claim 9 recites a unitary, L-shaped body wherein the first and second legs are integrally formed, whereas the Landis reference discloses a three-piece body consisting of mounting bracket 15, vertical leg 20, and attachment member 16.

As an initial matter, the examiner concluded that the Landis reference “discloses a support bracket for positioning within a rain gutter that includes an overlying gutter cover panel.” However, that reference does not disclose nor even suggest an overlying gutter cover panel that extends over a gutter to a point adjacent to a gutter upper front edge, as is recited in amended claim 9. Instead, it shows a roof 11 that only partially extends over the gutter, and that roof does not extend to the gutter upper front edge, as claimed in amended claim 9. Additionally, strut portion 30 of the Landis reference cannot be considered to be a cover panel, because as it is shown in Fig. 2 of that reference, it is a very narrow width member that cannot by any stretch of the imagination be a cover panel. And if strut portion 30 were a cover panel, as apparently suggested in the Action, because it is connected directly to the front edge of eaves trough 12 and extends directly to the rear edge of the trough it would completely block the trough, rendering it inoperative as a rain collector.

In the Action, the Landis reference was construed as disclosing the “at least one first bore extending through the first leg toward the mounting surface and generally aligned with the second leg for receiving a bracket fastener for securing the bracket to a substantially vertical building surface adjacent to a roof edge.” Element 36 of that reference was referred to in that context. But element 36 of the

Landis structure is an opening, and it does not serve in any way to secure the bracket to a substantially vertical building surface adjacent to a roof edge. Instead, it is disclosed as receiving an upstanding post 25 (see Landis, col. 2, lines 44-45). But such an upstanding post cannot operate to secure the bracket to a substantially vertical building surface, because both the post axis and the vertical building surface are parallel to each other, and because they are parallel to each other they cannot meet and cannot be interconnected.

The Landis reference was also construed as disclosing a second bore, referred to as “(generally at 32) extending into the second leg capable of receiving a cover panel fastener for securing a front edge of the gutter cove panel to the bracket.” But there is no gutter cover panel disclosed or suggested in the entire Landis reference. And element 32 is a rivet (see Landis, col. 2, line 31) that serves to attach strut portion 30 to eaves trough 12 (see Landis, col. 2, lines 29-32), not to a nonexistent and undisclosed gutter cover panel. Paragraphs c), d), and e) on page 3 of the Action also refer to the Landis reference as allegedly showing what is, in fact, a nonexistent and undisclosed gutter cover panel.

In view of the many structural distinctions noted above, the Landis reference neither discloses nor suggests the support bracket structure as it is claimed in amended claim 9. But in addition to the structural distinctions, claim 9 also includes functional recitations along with the structural recitations, and such functional recitations constitute limitations that must be disclosed in a reference in order for that reference to be a proper basis upon which to ground a finding of anticipation.

That functional limitations included in a claim must be considered and cannot be ignored was set forth by the Board of Patent Appeals as follows:

Although we have sustained several of the Examiner's rejections we here wish to specifically note that contrary to the Examiner's assertions, functional language in the claims must be given full weight and may not be disregarded in evaluating the patentability of the subject matter defined employing such functional language. However, the applicant must establish that what is taught by the reference does not inherently function in the same manner required by the claim; cf. *In re Hallman* decided by the CCPA July 16, 1981, 655 F.2d 212, 210 U.S.P.Q. 609.

Ex parte Bylund, 217 U.S.P.Q. 492, 498 (Bd. App. 1981).

And the Federal Circuit has held to the same effect. *K2 Corp. v. Salomon S.A.*, 52 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 1999) ("The functional language is, of course, an additional limitation in the claim.").

With regard to functional limitations in a claim MPEP §2173.05(g) states:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

Clearly, in view of the authorities cited above, the functional recitations contained in claim 9 are claim limitations, and thus they can serve to distinguish the claimed invention over the Landis reference. Those claimed functional limitations are not disclosed or suggested in the Landis reference, nor does the structure disclosed in

that reference inherently function in the same manner as the invention that is recited in amended claim 9.

In addition to the structural and functional distinctions between the invention as it is claimed in amended claim 9 and the structure and function disclosed in the Landis reference, in order for a reference to anticipate an invention as claimed, the reference must disclose each and every element recited in the claim. Indeed, the tests that must be met in order to warrant a conclusion of anticipation as expressed by the Court of Appeals for the Federal Circuit are quoted in MPEP §2131 as follows:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . . . “The identical invention must be shown in as complete detail as is contained in the...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Thus, each of the physical components recited in a claim, as well as each of other statements constituting limitations, which include functional recitations, must be disclosed in the reference in order for a conclusion of anticipation to be warranted.

In addition to not disclosing many of the structural elements and functional relationships that are recited in amended claim 9, the Landis reference also does not include the scope of disclosure that is necessary to enable one of ordinary skill in the art to make and use the invention as it is claimed, using the information contained in the Landis reference. In that regard, it has been held that:

For prior art to anticipate under 35 U.S.C. § 102(a) because it is "known," the knowledge must be publicly accessible, *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1370, 47 USPQ2d 1363, 1365 (Fed. Cir. 1998), and it must be sufficient to enable one with ordinary skill in the art to practice the invention, *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (CCPA 1965). *Minnesota Mining & Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1301, 64 USPQ2d 1270, (Fed. Cir. 2002).

Thus, if a reference is urged to constitute an anticipation of a claimed invention, then one having only ordinary skill in the art should be able to make and use the claimed structure based upon the disclosure contained in the allegedly anticipatory reference. The question then is – can one having before him the Landis reference make a bracket that responds to the claimed structure and that functions in the claimed manner? But because the Landis reference does not disclose an overlying gutter cover, it does not disclose a unitary L-shaped body, it does not disclose integrally formed first and second legs; it does not disclose a central panel extending between a mounting surface and a front surface of a first leg, it does not disclose a stop surface for abutment with and for positioning a front edge of a gutter cover panel, and it does not disclose an upwardly-facing flat surface means carried by the first leg for engaging a rear surface portion of a gutter cover panel, there is not sufficient disclosure in the Landis reference to enable one to make and use the claimed invention. Consequently, the disclosure of the Landis reference falls far short of meeting those judicially-mandated requirements that are necessary to warrant a conclusion of anticipation of the present invention as it is claimed in amended independent claim 9.

Claims 2-4, 10-13, and 15 each depend from claim 9, either directly or indirectly, and therefore each of those dependent claims also recites a structural arrangement that is not anticipated by the Landis reference, and for the same reasons as are given above in connection with amended independent claim 9. Moreover, it should be noted that claim 3 recites a blind bore, which is neither disclosed nor suggested in the Landis reference.

Claims 5-7 were rejected as obvious in view of the Landis '803 reference. The subject matter of claim 5, from which each of claims 6 and 7 formerly depended, has now been included in amended independent claim 9, and claims 6 and 7 have been amended to depend from claim 9. With regard to the subject matter of former claim 5, it was specifically acknowledged in the Action that the Landis reference "does not expressly disclose that the support surface is angled in a downward direction...toward the gutter front wall." But in addition to not expressly disclosing that orientation of the support surface and the angular relationship claimed in claims 6 and 7, there is not the slightest hint or suggestion in the Landis reference of any such orientation. In that regard, the support surface means was referred to at the bottom of page 3 of the Action as element 35, that allegedly serves "for engaging a rear surface of the gutter cover panel." But Landis does not teach or suggest an overlying gutter cover panel, and element 35 is specifically identified in the Landis reference at col. 2, line 40, as "a horizontal upper end flange," and it does not serve to engage and to support a rear surface portion of an overlying gutter cover panel. Furthermore, because Landis' element 35 is specifically disclosed as a horizontal element, it cannot be "inclined in a downward direction from a plane defined by the

mounting surface and extending toward the gutter front wall engagement means,” as was recited in former claim 5 and as is currently recited in amended claim 9. Thus, because there is no teaching or suggestion in Landis of other than a horizontal orientation of element 35, it would not be obvious to incline it as claimed, nor would it be obvious that element 35 be used for the purpose of engaging an undisclosed and nonexistent gutter cover panel.

Claims 6 and 7 are also not obvious based upon the Landis reference, and for the same reasons as are given above in connection with claims 5 and 9.

Claim 2 has been amended to recite that the two first bores extend through the first leg, which is not disclosed in the Landis reference.

Claim 10 has been amended to recite the orientation of the at least one aperture, which is not disclosed in the Landis reference.

Claims 11 and 12 have been amended to recite that the at least one bracket body aperture is positioned in a central panel of the respective leg, which is not disclosed in the Landis reference.

Based upon the foregoing amendments and remarks, the claims as they now stand in the application are believed clearly to be in allowable form in that they patentably distinguish over the disclosure contained in the reference that was cited and relied upon by the examiner, whether that reference be considered from an anticipation standpoint or from an obviousness standpoint. Consequently, this application is believed to be in condition for allowance, and reconsideration and reexamination of the application is respectfully requested with a view toward the issuance of an early Notice of Allowance.

The examiner is cordially invited to telephone the undersigned attorney if this amendment raises any questions, so that any such question can be quickly resolved in order that the present application can proceed toward allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Alfred J. Mangels', with a long horizontal flourish extending to the right.

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